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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,331	06/15/2000	Robert J. Mattila	1894-174	8526

22471 7590 12/30/2003

PATENT LEGAL DEPARTMENT/A-42-C
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EXAMINER

QUAN, ELIZABETH S

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,331

Applicant(s)

MATTILA ET AL.

Examiner

Elizabeth Quan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8 and 16-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 9, 10, 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-10, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 351 988 to McCulloch et al.

McCulloch et al. disclose a transporting and storing system comprising: a multiplicity of reagent packs (12) with each pack having a body with two generally opposite outer sides defined by the indentations into the sides of the reagent pack body; a gantry movable on a rack structure for carrying a gripper (21) with gripping jaws (20) for engagement with the two outer sides of the reagent pack by slipping each jaw within the indentation, such that the projecting portions of the reagent packs rests upon the jaws (fig. 1). McCulloch et al. disclose a storage nest comprising a multiplicity of compartments (11) aligned in vertical columns and horizontal rows, each compartment adapted for storing a reagent pack. The uppermost horizontal row (10a) of the compartment is considered by the Examiner to constitute the pipetting nest and the uppermost horizontal row compartments constitute the means for maintaining the precise pipetting position of the reagent pack for simultaneous pipetting via pipetters (14) along this uppermost row. Additionally, McCulloch et al. disclose at least one transport route for allowing movement of the gripper mechanism between the storage nest and the pipetting nest (col. 3, lines 23-31); means for positioning and retaining the reagent packs by the gripper mechanism, e.g. pack projections

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or grooves and complementary formations on the gripper (col. 4, lines 50-55). Although the wells of the pack are dozed with antibodies not specifically a reagent, this is considered by the Examiner a recitation of intended use of the claimed invention. Additionally, the limitation of the gripper mechanism having gripping jaws for engagement with the two outer sides of the reagent pack is also considered a recitation of intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPQ 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Alternatively, claims 9-10, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 351 988 to McCulloch et al. in view of U.S. Patent No. 6,159,425 to Edwards et al. or U.S. Patent No. 4,812,392 to Miyake et al. or U.S. Patent No. 5,417,922 to Markin et al.

Edwards et al., Miyake et al., and Markin et al. have been cited to demonstrate that it is well known to have a gripping mechanism with gripping jaws for engagement with two opposite outer sides of a reagent pack. In the event one would argue that the jaws of McCulloch et al. do not engage with the two opposite outer sides of the reagent pack, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of McCulloch et al. to use jaws that grip the opposite outer sides of the reagent pack to securely hold the reagent pack and allow access to the top and bottom of the reagent pack as taught by each of Edwards et al., Miyake et al., and Markin et al.

7. Claims 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 351 988 to McCulloch et al. alternatively in view of U.S. Patent No. 6,159,425 to Edwards et al. or U.S. Patent No. 4,812,392 to Miyake et al. or U.S. Patent No. 5,417,922 to Markin et al.

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McCulloch et al. disclose the means for positioning and retaining the reagent packs having projections or grooves and the gripper having complementary formations (col. 4, lines 50-55). McCulloch et al. do not recite the specific use of conical openings or conical pins. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the projections or grooves in a conical shape since Applicant has not disclosed that conical projections or grooves solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the projections or grooves of McCulloch et al.

Response to Arguments

8. Applicant's arguments filed 10/17/2003 have been fully considered but they are not persuasive. The added limitation does not make the claims patentable over prior art. McCulloch et al. disclose reagent packs with a body having two opposite outer sides. McCulloch et al. disclose that fork (20) supports and transports the plate carrier (col. 4, lines 37-40). It appears the fork (20) supports the plate carrier by engaging the indentation off the sides of the plate carrier, which contains the microtiter plate or reagent pack, such that the gripper grips the two opposite outer sides of the reagent pack. Examiner has also cited various references that explicitly disclose the engagement of the jaws with two opposite outer sides of reagent packs and their advantages.

Conclusion

9. Claims 9-10, 12-14 are rejected. Claims 1-6 allowed.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan
Examiner
Art Unit 1743

eq


Jill Warden
Supervisory Patent Examiner
Technology Center 1700